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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/402,731	02/10/2000	RAINER HAHN	(0)-6676.2	6338
7590 09/22/2004				
M ROBERT KESTENBAUM 11011 BERMUDA DUNES NE ALBUQUERQUE, NM 87111		EXAMINER WINAKUR, ERIC FRANK		
		ART UNIT 3736 PAPER NUMBER		
DATE MAILED: 09/22/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/402,731

Applicant(s)

HAHN, RAINER

Examiner

Eric F Winakur

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 February 2004 and 01 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 15-95 is/are pending in the application.
- 4a) Of the above claim(s) 34-88 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 6-13, 19, 20, 22-28, 30-33, 89 and 92-94 is/are allowed.
- 6) ☒ Claim(s) 1-5, 15-18, 21, 29, 90, 91 and 95 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-----------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 18 February 2004 has been entered.

Claim Objections

2. Claims 15 is objected to because of the following informalities: it appears that claim 15 should depend from claim 12. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1 - 5, 15, 16, 90, 91, and 95 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Although the specification discloses separate absorption and reflection (optical or sound) arrangements (Fig 7 and specification pages 38 - 39; Figure 8, specification pages 39 - 41), there is no teaching of a measuring

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device for measuring both absorption and reflection measurements (optical or sound), as set forth in claim 1, line 5.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 17, 18, 21, 29, 90 and 95 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 17 and 18 improperly depend from cancelled claim 14. With regard to claim 21, the phrase "the grip part" lacks antecedent basis. With regard to claim 29, the scope of the claimed subject matter is unclear, as the phrase "where appropriate an optical system" does not clearly define when an optical system is a required part of the invention. With regard to claim 90, the claim does not appear to provide a further structural limitation. With regard to claim 95, the phrase "the shoulder" lacks antecedent basis.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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8. Claims 1, 2, 90, 91, and 95 rejected under 35 U.S.C. 102(b) as being anticipated by Nuwayser (previously cited). Nuwayser teaches a dental caries detector that measures electrical conductivity. As written, claim 1 merely requires a measuring device capable of measuring at least one of the properties listed in claim 1. Nuwayser discloses such a device, and additionally has a cylindrical rod-like probe section (claims 2, 91). The probe includes a conical shoulder 20.

9. Claims 1, 2, 90, and 91 are rejected under 35 U.S.C. 102(b) as being anticipated by Settler et al. (previously cited). Settler et al. teach a pH measuring system that is suitable for dental applications, including measurements of carious tissue. As written, claim 1 merely requires a measuring device capable of measuring at least one of the properties listed in claim 1. Settler et al. discloses such a device, and additionally has a cylindrical rod-like probe section (claims 2, 91).

10. Claims 1, 2, 90, and 91 are rejected under 35 U.S.C. 102(e) as being anticipated by Heckenberger (previously cited). Heckenberger teaches a device for recognition of bacterial infection of teeth. As written, claim 1 merely requires a measuring device capable of measuring at least one of the properties listed in claim 1. Heckenberger discloses such a device, and additionally has a cylindrical rod-like probe section (claims 2, 91).

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over any of Nuwayser, Settler et al., or Heckenberger, as applied to claim 2, further in view of Ackerman et al. The references (Nuwayser, Settler et al., and Heckenberger) teach various dental examination devices, but do not teach measurement of position of the probe in relationship to a surface of the tissue under examination. Ackerman et al. teach a measuring probe for use in dental examinations to provide distance measurements to assist in diagnosis of periodontal disease (column 3, line 67). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify any of Nuwayser, Settler et al., or Heckenberger to include a distance measuring probe, as taught by Ackerman et al., since Ackerman et al. teach that this will assist in diagnosis of periodontal disease.

Allowable Subject Matter


13. Claims 6 - 13, 19, 20, 22 - 28, 30 - 33, 89, and 92 - 94 are allowed.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric F Winakur whose telephone number is 703/308-3940. The examiner can normally be reached on M-Th, 7:30-5; alternate Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on 703/308-3130. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Eric F Winakur
Primary Examiner
Art Unit 3736

20 September 2004